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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,280	07/09/2004	David Smith	013344-9047-00	5678
23409 7590 06/21/2007 MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202			EXAMINER MILLS, DANIEL J	
			ART UNIT 3679	PAPER NUMBER
			MAIL DATE 06/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/501,280

Applicant(s)

SMITH, DAVID

Examiner

Daniel J. Mills

Art Unit

3679

DSM

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/29/2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Election was made **without** traverse in the reply filed on 3/30/2006.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 17 includes the limitation "said second opening is undersized with respect to the third components, and one of the third components (11, 12) is forced into said undersized second opening" (lines 9-11) which was not originally disclosed for the elected species. Applicant points to page 4 lines 20-22 of applicant's original disclosure as providing support for this feature. It appears however that this design element was originally disclosed as part of the "pallet", which is a non-elected species, and was not specified or disclosed as part of the elected "fence". Applicant only disclosed the undersized holes in reference to pallet members 2 and included no disclosure of a similar feature in the fence members 9.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 includes the limitations "the first (8) and second (9) components fitting together by one of the components (9) fitting into a first opening in the other component (8) ... and one of the third components (11, 12) is forced into said undersized second opening ... abutting the inner wall of the other component " (lines 5-12) which renders the claim unclear. Applicant is attempting to refer to three named components as either the "one" or "the other" which is unclear.

Claim 17 recites the limitation "the one of the components having a second opening" in line 7. There is insufficient antecedent basis for this limitation in the claim, does "the one of the components" have a first opening also?

Claim 17 recites the limitation "the other component" in lines 6, 8, and 11. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "an aperture" in line 1, this is a double inclusion of "a first opening in the other component" (claim 17 line 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 18, 20-22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuo (JP 2001-262871).

Regarding claim 17, 18, 20-22, and 24-26 Mitsuo discloses a fence with interlocked components comprising a plurality of upright spaced apart posts (10) each post comprising a first tubular component; at least one cross rail (20) extending between two posts, said cross rail comprising a second tubular component (comprised of two end to end adjacent rails 20); and a plurality of third components (40); the first and second components fitting together by one of the components fitting into a first opening in the sidewall of other component and the one of the components having a second opening which lies within the hollow interior of the other component and one of the third components being forced into said second opening, to lie within the other component, abutting the inner wall of the other component thus locking all the components together, with base plate (12) which are capable of being secured to a support surface, with posts having a square cross-section, in which two third components (the two vertical sections of 40) are inserted into each second component (comprised of two end to end adjacent rails 20), the two third components being spaced apart to abut respectively against opposite inner walls of the first component, thus preventing the second component (comprised of two end to end adjacent rails 20) from moving with respect to the first component.

Mitsuo fails to disclose that the third component is tubular, however, it would have been a simple matter of engineering design choice at the time of applicant's invention to use a tubular pin rather than a solid pin to reduce the weight of the pin and no unexpected effects would have resulted from this modification.

Mitsuo fails to disclose the use of plastic material for the fencing components, however, it would have been a simple matter of engineering design choice at the time of applicant's invention to use plastic material for the fencing components to improve the corrosion resistance of the fence. The selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, applicant has not established the criticality of this design choice to his invention, nor has applicant established that unexpected effects would have resulted from the use of plastic for the fence.

Mitsuo fails to disclose that the second and third components have a substantially rectangular cross-section, however, it would have been a simple matter of engineering design choice for one of ordinary skill in the art at the time of applicant's invention to change the shape of the components to be rectangular for improved aesthetics and cheaper construction. A change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Furthermore, applicant has not established the criticality of this design choice to his invention, nor has applicant established that unexpected effects would

have resulted from the use of second and third components with a rectangular cross-section.

Mitsuo fails to disclose that the second opening is undersized with respect to the third components and that one of the third components is forced into the undersized second opening. However, it would have been a simple matter of engineering design choice for one of ordinary skill in the art at the time of applicant's invention to optimize the second opening to fit the third component in order to ensure the retention of the third component.

Claims 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuo (JP 2001-262871) as applied above, and further in view of Murphy (US 3,957,250).

Regarding claims 19 and 23, Mitsuo fails to disclose the use of foundation bars. Murphy teaches the use of foundation bars (15 and 16) to anchor the post (10) and prevent it from rotating (column 3 lines 64-68). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the arrangement of Mitsuo to use foundation bars to anchor the post and prevent it from rotating as taught by Murphy.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warner (WO 9711241).

Regarding claims 17 and 18, Warner discloses a fence with interlocked components comprising a plurality of upright spaced apart posts (3) each post comprising a first rectangular tubular component; at least one cross rail (4) extending between two posts, said cross rail comprising a second rectangular tubular component; and a plurality of third tubular components (6); the first and second components fitting together by one of the components fitting into a first opening in the sidewall of other component and the one of the components having a second opening which lies within the hollow interior of the other component and one of the third components being forced into said second opening, to lie within the other component, abutting the inner wall of the other component thus locking all the components together, with posts having a square cross-section.

Warner fails to disclose the use of plastic material for the fencing components, however, it would have been a simple matter of engineering design choice at the time of applicant's invention to use plastic material for the fencing components to improve the corrosion resistance of the fence. The selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, applicant has not established the criticality of this design choice to his invention, nor has applicant established that unexpected effects would have resulted from the use of plastic for the fence.

Warner fails to disclose that the third components have a substantially rectangular cross-section, however, it would have been a simple matter of engineering



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design choice for one of ordinary skill in the art at the time of applicant's invention to change the shape of the components to be rectangular for improved aesthetics and cheaper construction. A change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Furthermore, applicant has not established the criticality of this design choice to his invention, nor has applicant established that unexpected effects would have resulted from the use of second and third components with a rectangular cross-section.

Warner fails to disclose that the second opening is undersized with respect to the third components and that one of the third components is forced into the undersized second opening. However, it would have been a simple matter of engineering design choice for one of ordinary skill in the art at the time of applicant's invention to optimize the second opening to fit the third component in order to ensure the retention of the third component.

Claims 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warner (WO 9711241) as applied above, and further in view of Murphy (US 3,957,250).

Regarding claims 19 and 23, Warner fails to disclose the use of foundation bars. Murphy teaches the use of foundation bars (15 and 16) to anchor the post (10) and prevent it from rotating (column 3 lines 64-68). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the

arrangement of Warner to use foundation bars to anchor the post and prevent it from rotating as taught by Murphy.

### ***Response to Arguments***

Applicant's arguments filed 3/29/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a slight shoulder created on either side of the compressed region", "with the third component being tubular, that component can also be pierced with another component, for example a support pin for a traffic direction notice" ) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Mills whose telephone number is 571-272-8115. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM

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6/10/2007



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